

REMARKS

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

Claims 1, 13 and 18-20 have been amended.

No new matter has been added.

Claim Rejections - 35 USC § 103

Claims 1-7 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corbin USPN 5,138,712, in view of McGuire et al. USPN 6,493,871 B1 and further in view of Misra et al. USPN 6,189,146 B1.

Claims 1, 13 and 18-20 have been amended to clarify that which applicant regards as the invention. That is, such claims have been amended to correct for antecedent basis errors by including the antecedent basis that the software is downloaded from the network computer program storage device based on the previous step of verifying that the end user computer identifier is listed in the network computer database. (See, specification page 11, lines 3-12 and Fig. 5.)

Applicant respectfully submits that the foregoing amendments do not necessitate a further search of the art as they merely correct for antecedent basis, as well as for the reason that the previously presented claims broadly covering such limitation, and as such, should have been previously searched by the Examiner.

Independent claims 1, 13 and 18-20 clarify that the methods, and program storage device, computer program product, and article for executing such methods, include providing an end user computer having a program storage device and a unique computer identifier distinguishing the end user computer from other computers. A network computer is also provided that has access to a program storage device containing software including programs to be executed by the end user's computer and database information for license to end users and a program storage device containing a database listing computer identifiers licensed to run the software. The network computer contacts the end user computer to determine the end user computer identifier, and then verification is made that the end user computer identifier is listed in the network computer database. Based on this verification that the end user computer identifier is fact listed in the network computer database, the software is then downloaded from the network computer program storage device. Using the network computer, the downloaded software is then installed on the end user computer program storage device such that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another computer.

Independent claim 9 has not been amended as such limitation is already set forth in the previously presented claim. In particular, after the network computer contacts the end user computer and determines its end user computer identifier, claim 9 recites that verification is then made that the end user computer identifier is listed in the network computer database. All of the software on the network computer program storage device listed as licensed (which is based on the previous verification step) by the computer

identifier of the end user computer is then identified to the end user computer. A selection of such software to be downloaded is then sent from the end user computer to the network computer, the selected software downloaded and then using the network computer, it is installed on the end user computer program storage device for execution on the end user's computer. This downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another computer.

Thus, applicant continues to submit that each and every independent claim is directed to first verifying licensing, and then based on such license verification, downloading from a network computer and installing to the end user's computer software which comprises either programs to be executed by the end user's computer or database information.

Applicant continues to submit that in contrast to applicant's claimed invention, the Corbin patent teaches a system in which, at the time the license is checked, the executable software applications to be used are already present on the computer storage device on which they are to be executed. It discloses providing the software application itself with the verification and license check out functions, which are normally performed by a license server of a network software license system. (Abstract, col. 2, lines 30-34, col. 4, lines 32-37, col. 7, lines 1-4.)

In more detail, the Corbin patent discloses a license service 14 that is shared by every agent connected to a computer network environment. (Col. 5, lines 7-9.) The shared license service 14 includes license servers and databases that store licensing information for various software applications that are purchased and authorized to run in the computer

network environment. (Col. 5, lines 10-30.) Each license server 20 operates on an agent and interfaces the database 18 to a license administration tool 21, licensing library 24 and license service binder 29. (Col. 6, lines 8-13.) The licensing library 24, comprising a set of library routines, is linked with the application 26 and communicates with the license server 20 for enabling the application 26 to request licensing service from the license server 20. (Col. 6, lines 35-37 and 40-44.) Upon receiving the request for service from the licensing library 24, the license server 20 retrieves a license token from the database 18 and transmits it to the licensing library 24. (Col. 6, lines 37-40.)

As disclosed in Corbin, "[t]he application is installed and linked to the licensing library using standard operating system utilities of the agent executing the licensing library and the application." (Col. 6, lines 49-52, *See also*, col. 6, lines 62-66.) That is, the application is installed on the agent connected to the computer network whereby the "licensing library coupled to the application performs the procedure of authenticating the license token prior to granting a license and therefore access to run the application." (Col. 11, lines 64-67.)

Again, when the already-installed application is to be executed, it is a license token, and not the application, which is downloaded from the license server. *See*, Corbin Fig. 3 and column 7, lines 46 to column 8, line 25. ("Applications 41, 42 and 43 are shown requesting licensing service from the license server 44. When a customer purchases a license for an application, ... the software vendor creates a license token with a license production tool, and delivers the license token to the customer's network administrator. ... The license sever is now ready to entertain requests from application 41, 42 and 43 for a

license to use the application corresponding to token 46 as well as other applications represented in database 46.”)

Applicant's continue to submit that the present invention, as claimed, is patentably distinct from, and not anticipated by or obvious from Corbin since applicant here downloads not a license token, but instead the actual software consisting of programs to be executed by the end user's computer and database information (claims 1, 18, 19 and 20), programs for execution on end user computers (claims 3 and 9), or an executable software program to replace a damaged executable software program for execution on end user computers (claim 13). Corbin's download of only a licensing token does not disclose or suggest downloading the executable software program or database to which applicant's invention is directed. Applicant submits that Corbin teaches away from the present invention since Corbin's license token system begins with the applications loaded in the database employed by the user. On the contrary, applicant's invention begins with the executable program or database present on a network computer program storage device, and subsequently installs the downloaded executable program or database onto the end user computer program storage device.

The Examiner recognizes that Corbin doesn't explicitly disclose software selected from the group consisting of programs to be executed by the end user's computer and database information, and cited McGuire to remedy this deficiency. The Examiner states that McGuire discloses this feature (7-47-52, see update data and database), and therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Corbin with McGuire because listing and selecting software from a

central location for downloading as needed in a distributed architecture, makes loading updated and needed files more efficient.

Applicants continue to submit that McGuire does not remedy the deficiencies of Corbin. McGuire is limited to methods and systems for downloading updates for software programs already installed on a client computer. (Col. 4, lines 13-16.) The client computer first obtains from a setup server an initial setup package, which includes a setup program and a list of files required for installing the software product on the client computer. (Col. 4, lines 17-21.) The setup program running on the client computer determines whether some current or earlier versions of those files required for installation already exist on the client computer, and compiles a download request with a list of files needed for updating the client to provide the required installation files. (Col. 4, lines 21-27.) The download request is sent to a second server storing a collection of update data, and in response, the second server prepares and downloads update files corresponding to the requested files to the client, whereby the setup program updates the existing files to create and install the revised software product on the client computer. (Col. 4, lines 27-37.) (See *also*, column 7, lines 28-56.)

In view of the foregoing, applicant continues to submit that McGuire teaches that the setup program is initially installed and running on the client computer for making requests to the second server. Further, the client computer requests only the updated files needed to be downloaded from the server, and not the entire program. McGuire does not disclose, contemplate or suggest that the steps of first verifying licensing, and then based on such license verification, downloading from a network computer and installing to the

end user's computer software which comprises either programs to be executed by the end user's computer or database information, as is currently claimed. Further, the server or network computer of McGuire does nothing to contact the client or end user computer to determine its identifier and verify that the end user is listed in the network computer's database as licensed to run the software, and it does not actually install the downloaded software, since this is done by the client or end user computer.

Further in the above office action, the Examiner states that Corbin as modified by McGuire doesn't disclose that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another. To remedy this deficiency, the Examiner cites Misra, stating that it "discloses this functionality in analogous art (Col. 15: 27-35)." Applicant disagrees.

It is submitted that Misra does not overcome the deficiencies of either Corbin or McGuire, alone or in combination. Misra is limited to systems and methods for enforcing software licenses and preventing copying of software licenses –not the software as is currently claimed. (Col. 1, lines 6-8.) Misra discloses that when a company wants a software license, it sends a purchase request to a licensing clearinghouse where a license pack is generated that contains a set of one or more individual software licenses. (Col. 2, lines 32-36.) To prevent the license pack from being copied and installed on multiple license servers (from one client machine to another), a unique license pack ID is assigned to the license pack and associates the license pack ID with the license server in a secure master license database kept at the licensing clearinghouse. (Col. 2, lines 37-41 and col. 15, lines 29-32.) In preventing copying of the license pack, the license generator also

digitally signs the license pack and encrypts it with the license server's public key. (Col. 2, lines 41-43.)

Misra does not disclose, contemplate or suggest verification of a license prior to downloading software from a network computer, followed by installation of such software to an end user's computer, whereby the software comprises either programs to be executed by the end user's computer or database information, as is currently claimed.

As stated within *In re Murray, et al.*, 122 USPQ 364, "The question of obviousness must be approached without recourse to applicant's disclosure." Let it be assumed that one had before him the references of Corbin, McGuire and Misra, and that person was unfamiliar with the disclosure of the subject invention, that person would not be lead to applicant's invention which is directed to first verifying licensing, and then based on such license verification, downloading from a network computer and installing to the end user's computer software which comprises either programs to be executed by the end user's computer or database information. Again, Corbin is limited to an already-installed application on an agent connected to a computer network whereby a licensing library coupled to the application authenticates a license token prior to granting a license and therefore access to run such application. McGuire is also limited to methods and systems for downloading updates for software programs already installed on a client computer. Misra is limited to preventing a license pack for software from being copied and installed from one client machine to another.

Therefore, for the Examiner to state that it would be obvious to use a network computer to check for a license before itself installing a program to be executed by the end

user's computer or database information means that the Examiner is using the disclosure of the present invention as a reference in combination with Corbin, McGuire and/or Misra. In the past, this type of using one's own disclosure as a reference has not been permitted under the Patent Laws. Additionally, the basic mandate inherent in 35 U.S.C. 103 is that piecemeal reconstruction of the prior art patents in light of one's disclosure shall not be a basis for the conclusion of obviousness as stated within In re Kamm 172 USPQ 298. It appears to applicant that the Examiner is reconstructing Corbin on the basis of McGuire and/or Misra and in view of applicant's own disclosure. In view of In re Kamm, this type of rejection has not been permitted which uses as a benefit applicant's own disclosure.

It is for these reasons that applicant submits that claims 1-7 and 9-20 are neither anticipated by nor obvious over Corbin, McGuire or Misra, alone or in any proper combination thereof.

Claim Rejections - 35 USC § 103


The Examiner has rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Corbin USPN 5,138,712, in view of McGuire et al. USPN 6,493,871 B1, further in view of Misra et al. USPN 6,189,146 as applied in claim 1, and further in view of Bartholomew et al. USPN 6,202,209 B1.

Applicant's claim 8, dependent on claim 1, specifies that the end user computer program storage device contains a damaged version of the software to be downloaded, and that the installation of said software corrects the damaged software. For the reasons discussed above in connection with claim 1, the hypothetical combination of Corbin's download of only a license token to an already-installed software application, McGuire's

use of a setup program already installed at the end user's computer, with no license verification, and Misra's preventing of a license pack from being copied and installed from one client machine to another, does not disclose or suggest applicant's claimed downloading of the entire executable software program to replace a damaged version of the executable software. Bartholomew is directed to a PCMCIA personal information device, and not to downloading of licensed software. Bartholomew's disclosure does not correct the deficiency of the Corbin, McGuire and Misra references, and therefore the hypothetical combination does not arrive at applicant's invention as specified in claim 8.

It is respectfully submitted that the application has now been brought into a condition where allowance of the case is proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited. Should the Examiner not find the claims to be allowable, Applicants' attorney respectfully requests that the Examiner call the undersigned to clarify any issue and/or to place the case in condition for allowance.

Respectfully submitted,


Kelly M. Reynolds
Reg. No. 47,898

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595
ibmf100268000amdD.doc